

REMARKS

After entry of the foregoing amendment, claims 1-11 are pending in the application.

Claims 5-11 are newly added. Support therefore is found, e.g., in paragraphs 6 and 14-19 of the published specification, and in the Appendices.

Claims 1 and 3 stand rejected as anticipated by Tewfik (6,272,634). Claims 2 and 4 stand rejected as obvious over Tewfik in view of Zenith (6,519,771). The rejections are respectfully traversed.

Claim 1 is directed to “an interactive video origination system employing a layered architecture. Tewfik does not teach such a system.

Claim 3 is directed to “an interactive video consumer system employing a layered architecture.” Again, Tewfik does not teach such a system.

In mapping Tewfik to the claims, the Office has argued that the “layered architecture” limitation is met by “the internet.” However, this is incorrect.

In adopting this position, the Office seems to be giving these limitations the broadest possible interpretation that a dictionary might allow. However, as recently made clear by the Federal Circuit, such a dictionary interpretation should be *not* the proper standard to be applied by the Office. Instead, “*dictionary definitions must give way to the meaning imparted by the specification.*”¹

Construed by reference to the specification, the “interactive video ... system employing a layered architecture” that is required by the claims is not met by “the internet.” Instead, such terms require a protocol stack of the sort exemplified in applicant’s specification and in the attached Appendices.

Regarding the obviousness rejections, applicant respectfully submits that the Office has not met its burden of setting forth a convincing rationale as to why an artisan would modify and combine the references in the manner asserted.

For example, the Action contends:

¹ *In re Johnston*, No. 05-1321, slip op. at 3 (Fed. Cir. 2006), citing *Philips v. AWH Industries*, 415 F.3d 1303 (Fed. Cir. 2005).

Tewfik and Zenith are analogous art because they both come from the same field of endeavor, namely the field of interactive multimedia distribution.

However, Tewfik is not understood to come from the field of interactive multimedia distribution. Indeed, Tewfik's specification does not even appear to mention any interactivity. Accordingly, the predicate for the proposed combination fails.

Moreover, the Office works from hindsight when it contends:

It would have been obvious to a person of ordinary skill in the art to make the watermarking system of Tewfik ATVEF compliant so that it is a part of a widely supported, non-proprietary standard.

This starts from the final outcome disclosed by applicant's specification, and justifies the proposed combination by working backwards.

A proper motivation to modify and combine generally requires recognition of a particular problem, coupled with an obvious realization that the problem can be addressed by borrowing teachings from another reference.²

What problem would an artisan have recognized from Tewfik's system? Applicant respectfully submits, 'none.'

*"The factual inquiry whether to combine references must be thorough and searching."*³ The need for specificity in the rejection pervades the case law.⁴ *"Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."*⁵

² Recognition of a problem, alone, is not enough. Case law establishes that an invention may be patentable even if the solution is obvious once the source of the problem is identified. *In re Zurko*, 111 F.3d 887 (Fed. Cir. 1997); *In re Spinnoble*, 405 F.2d 578 (CCPA 1969).

³ *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001).

⁴ *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

⁵ *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

It is improper, in determining whether a person of ordinary skill would have been led to a combination of references, simply to "[use] that which the inventor taught against its teacher."⁶ Yet that is the foundation on which the present rejection seems based.

In view of such shortcomings, other points that might be made concerning the rejections, the art, and the claims are not belabored.

Favorable reconsideration and passage to issuance are solicited.

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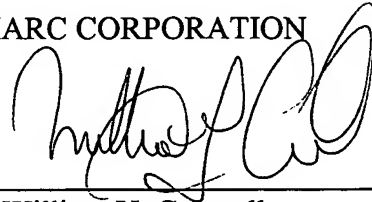
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Respectfully submitted,

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⁶ In re Sang Su Lee, *ibid*, citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).